

## REMARKS

Claims 1, 4-6 and 10-14 are currently pending in the application. Claims 4, 5, 10 and 14 are canceled in the present reply. Claims 1, 6 and 11-13 are currently amended. These claims have been canceled or amended without prejudice to, or disclaimer of, the subject matter thereof. Applicant reserves the right to file continuing applications directed to the subject matter of any claim canceled or amended for any reason.

The amendments to claims 1, 6 and 11-13 place the application in better condition for examination. It is submitted that no new matter has been introduced by these amendments with support found throughout the specification as filed. By these amendments, Applicant does not acquiesce to the propriety of the Office's rejections and does not disclaim any subject matter to which Applicant is entitled. *Cf. Warner Jenkinson Co. v. Hilton-Davis Chem. Co.*, 41 USPQ.2d 1865 (US 1997).

### **I. Specification**

The Office notes that the specification uses trademarks and points out that trademarks should be capitalized with generic terminology also provided. Office Action mailed September 17, 2009 ("OA"), page 2. Applicant believes that all trademarks are capitalized with generic terminology provided. If the Office disagrees, identification of incorrectly identified trademarks is respectfully requested.

### **II. Obviousness-Type Double Patenting Rejections**

Claims 1, 4-6 and 10-14 stand rejected on the ground of non-statutory obviousness-type double patenting over claims 1-8 of U.S. Patent No. 6,974,807. OA, page 3. Applicant respectfully disagrees. Nonetheless, and solely to expedite prosecution of the pending application, a terminal disclaimer over U.S. Patent No. 6,974,807 is filed herewith. Accordingly, Applicant respectfully requests that the Office reconsider and withdraw the pending obviousness-type double patenting rejections of claims 1, 4-6 and 10-14 over U.S. Patent No. 6,974,807.

### **III. Claim Objections**

The Office objects to claims 4 and 5 as being improper dependent claims. Claims 4 and 5 have been canceled. Accordingly, these objections are moot.

### **IV. 35 U.S.C. § 112 Rejections**

Claims 1, 4-6 and 10-14 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement because, according to the Office, the specification does not support “1.0% tazarotene.” OA, page 4. Applicant respectfully disagrees. Nonetheless, and solely to expedite prosecution, Applicant has amended the claims to recite from about 0.1% to about 2% tazarotene as particularly provided at page 5, lines 19-23 of the specification. Accordingly, Applicant respectfully requests that the Office reconsider and withdraw the pending rejections of claims 1, 4-6 and 10-14 under 35 U.S.C. § 112, first paragraph.

**V. 35 U.S.C. § 103 Rejections**

**A. Claims 1, 6, 12 and 13 over Yamamoto and Nagpal**

Claims 1, 6, 12 and 13 stand rejected under 35 USC § 103(a) as unpatentable over U.S. Patent 5,236,906 (“Yamamoto”) in view of U.S. Patent 5,650,279 (“Nagpal”). OA, page 5. Applicant respectfully disagrees.

To maintain a proper rejection under 35 U.S.C. § 103, the Office must meet four conditions to establish a *prima facie* case of obviousness. First, the Office must show that the prior art suggested to those of ordinary skill in the art that they should make the claimed composition or device or carry out the claimed process. Second, the Office must show that the prior art would have provided one of ordinary skill in the art with a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be adequately founded in the prior art and not in an applicant’s disclosure. Third, the prior art must teach or suggest all the claim limitations. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). Fourth, if an obviousness rejection is based on some combination of prior art references, the Office must show a suggestion, teaching, or motivation to combine the prior art references (“the TSM test”). *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Following *KSR Int’l Co. v. Teleflex, Inc.*, this fourth prong of the *prima facie* obviousness analysis must not be applied in a rigid or formulaic way such that it becomes inconsistent with the more flexible approach of *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966); 127 S. Ct. 1727 (2007). It must still be applied, however, as the TSM test captures the important insight that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* at 1741 (citing *United States v. Adams*, 383 U.S. 39, 50-52 (1966)).

As amended the claims recite that the corticosteroid is alclometasone dipropionate and/or betamethasone valerate. This subject matter coincides with the previous scope of claim 10 which was not rejected over the cited art. Applicant asserts that this scope is indeed allowable because neither Yamamoto nor Nagpal teaches or suggests this limitation or suggests to one of ordinary skill in the art that the claimed method be carried out. As such, it follows that no reasonable expectation of success is provided. Based on the foregoing, Applicant respectfully requests that the Office reconsider and withdraw the pending rejections of claims 1, 6, 12 and 13 under 35 USC § 103 over Yamamoto in view of Nagpal.

**B. Claims 1, 6, 12 and 13 over Smith, Sequeira and Nagpal**

Claims 1, 6, 12 and 13 stand rejected under 35 USC § 103(a) as unpatentable over U.S. Patent 5,874,074 (Smith), U.S. Patent No. 4,775,529 (Sequeira) and Nagpal. OA, page 6. Applicant respectfully disagrees.

As amended the claims recite that the corticosteroid is alclometasone dipropionate and/or betamethasone valerate. This subject matter coincides with the previous scope of claim 10 which was not rejected over the cited art. Applicant asserts that this scope is indeed allowable because neither Smith, Sequeira nor Nagpal teaches or suggests this limitation or suggests to one of ordinary skill in the art that the claimed method be carried out. As such, it follows that no reasonable expectation of success is provided. Based on the foregoing, Applicant respectfully requests that the Office reconsider and withdraw the pending rejections of claims 1, 6, 12 and 13 under 35 USC § 103 over Smith and Sequeira in view of Nagpal.

**VI. Other Matters**

The Office notes typographical errors in claims 1 and 14. OA, page 7. Applicant thanks the Office for the notice and opportunity to address these errors. The typographical error has been removed from claim 1 and claim 14 has been canceled.

**CONCLUSION**

Applicant submits that the present application is now in condition for allowance. If the Examiner has any questions or believes further discussion will aid examination and advance prosecution of the application, a telephone call to the undersigned is invited. If there are any additional fees due in connection with the filing of this amendment, please charge the fees to undersigned's Deposit Account No. 53-3207. If any extensions or fees are not accounted for, such extension is requested and the associated fee should be charged to our deposit account.

Respectfully submitted,

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